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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,249	07/11/2003	Francis B. Brake JR.	47004.000251	4607

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11/30/2005

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EXAMINER

HARBECK, TIMOTHY M

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/618,249	BRAKE ET AL.	
	Examiner	Art Unit	
	Timothy M. Harbeck	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/22/2003</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,032,136. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the pending application is substantially the same as claim 1 of the previous patent. The difference is that the pending application relates to a "value card" whereas the previous patent refers to a "multi-feature card". It would have been obvious to anyone skilled in the ordinary art at the time of invention to equate a value card with multiple features as claimed to be a "multi-feature card," because it performs more than one particular function.

Furthermore, the remaining scope of claim 1 in the pending application is a broader interpretation of the remaining scope of claim 1 in the previous patent. Because of this, the entire scope of the pending claims is covered by the previously

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patented claims. Broadening the scope of the prior patent would have been obvious to anyone skilled in the ordinary art at the time of invention so that one could cover a wider range of the particular subject.

Claim Objections

Claims 9-12 and 15 are objected to because of the following informalities: The cited claims depend upon "the payment amount source" of claim 6, however there is no antecedent basis for this term in claim 6. Examiner believes that the applicant meant to refer to claim 8 where the full use of the term is disclosed and has examined the application under this assumption. Nonetheless, appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 14 are rejected under the second paragraph of 35 U.S.C. 112

Claims 13 and 14 recite the limitation "primary amount source.". There is insufficient antecedent basis for this limitation in the claim. For the purposes of a prior art search the examiner has interpreted "primary amount source" to mean "payment amount source," which has a proper antecedent basis in claim 8 and has been examined under this assumption.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US Pat 6,014,645) in view of "Visa, MBNA and De La Rue Launch Multi-Function Smart Card Program," De La Rue Pic 7/06/1998 (hereinafter De La Rue).

Re Claim 1: Cunningham discloses a real-time financial card application system wherein the system automatically processes a customer's application for a transaction card (Column 2, lines 9-29) comprising the steps of:

- Receiving said customer's request into said system (Column 2, lines 15-19)
- Providing at least one or more safety features to determine whether said customer is the person whose name is printed on said transaction card (Column 3, lines 23-26)
- Activating the transaction card by confirming the customers desire to activate the primary transaction card use

Cunningham does not explicitly disclose the steps of offering the options of activating the transaction card by

- Determining the customer's election to add a secondary credit card feature; and
- Identifying the customer's request to activate any additional features

De La Rue discloses a Visa smart card that will place the functions of several traditional bank cards onto a single microchip (single card). These additional features include a credit feature, a stored cash feature and a rewards program. It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of De La Rue to the disclosure of Cunningham to create a real time credit card application system and method that would include a multifunction credit card. The system of Cunningham, while originally adapted to automatically apply and activate a traditional credit card would be well served to adapt the system to allow customers to activate the multi-purpose card with multiple functions because many customers would be interested in having this type of card as opposed to many separate cards in an effort to streamline their financial transactions onto one source as opposed to many separate sources. This is the next step in the evolution of the credit card and if the system did not adapt to these changes, customers would seek out a different system that would better suit their needs.

Re Claim 2: Cunningham in view of De La Rue discloses the claimed method supra and De La Rue further discloses wherein the transaction card use and the secondary credit feature perform different types of card functions and the use of the transaction card use and the secondary credit feature enables the customer to establish different relationships with different types of businesses and industries (See entire document but specifically paragraphs 2 and 4).

Re Claim 3: Cunningham in view of De La Rue discloses the claimed method supra and De La Rue further discloses wherein the additional use features has a rewards feature (See paragraph 3)

Re Claim 4: Cunningham in view of De La Rue discloses the claimed method supra and De La Rue further discloses wherein the rewards feature can be redeemed or spent at a specific vendor (Paragraph 4; see dinner entrée example)

Re Claim 5: Cunningham in view of De La Rue discloses the claimed method supra and De La Rue further discloses wherein the rewards feature can be redeemed or spent at several vendors (Paragraph 4; "merchants").

Re Claim 6: Cunningham in view of De La Rue discloses the claimed method supra and De La Rue further discloses wherein the rewards feature can be redeemed or spent at any vendor or merchant who accepts the logo printed on the transaction card (paragraph 4).

Re Claim 7: Cunningham in view of De La Rue discloses the claimed method supra and De La Rue further discloses wherein the rewards feature is used as a credit against the secondary feature to reduce the balance of the secondary credit card feature (paragraph 4; This essentially defines the rewards feature; purchasing a product with rewards points reduces the secondary credit balance up to the amount of the purchase).

Re Claim 8: Cunningham in view of De La Rue discloses the claimed method supra and while not explicitly disclosing wherein the customer must agree to establish a credit account with a payment amount source in order to activate the primary

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transaction card use, De La Rue discusses the combination of a credit, stored value and loyalty functions onto a single smart card (paragraph 1), which means that these accounts are in fact established with a payment amount source prior to any other use.

Re Claims 9-12: As previously noted in the rejection of Claim 8, the multi function smart card combines the credit (credit card), stored value (debit card) and loyalty functions onto a single card, which establishes the payment amount sources as these particular cards. While not explicitly disclosing that the payment amount source is a check, it was well known in the art at the time of invention that often times a debit card is linked to a standard checking account, from which paper check can be written, and in a sense a debit card is just an electronic version of a paper check.

Re Claim 13: Cunningham in view of De La Rue discloses the claimed method supra and while not explicitly disclosing wherein the customer may automatically recharge the primary amount source when the payment source is depleted, this step was well known in the art at the time of invention. It has previously been established that the payment source can be either a debit card or a personal check that are almost always linked to a standard checking account at a particular bank. The step of automatically recharging the amount source when the payment source is depleted is therefore just a simple deposit of money into the account through an automated means such as a automatic deduction from a paycheck that is normally directly deposited in to the account, a process that was notoriously well known in the art.

Re Claim 14: Cunningham in view of De La Rue discloses the claimed method supra and while not explicitly disclosing wherein the customer may recharge the primary

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amount source when the payment source is depleted. It has previously been established that the payment source can be either a debit card or a personal check that are almost always linked to a standard checking account a particular bank. The step of recharging the amount source when the payment source is depleted is therefore just a simple deposit of money into the account, a process that is notoriously well known in the art.

Re Claim 15: Cunningham in view of De La Rue discloses the claimed method supra and while not explicitly disclosing wherein the payment amount source is the secondary credit card feature, it was established in the rejection of claims 10-12 that the payment amount source may be one of a credit card or debit card. De La Rue discloses that the multi purpose card can have a credit / stored value hybrid card, wherein the stored value card acts as the secondary feature. It would therefore be obvious, through the transitive property, that if the debit card can be the payment amount source as the secondary credit feature.

Re Claim 16: Cunningham discloses a real-time financial card application system wherein the system automatically processes a customer's application for a transaction card (Column 2, lines 9-29) comprising the steps of:

- Receiving said customer's request into said system (Column 2, lines 15-19)
- Activating the transaction card by confirming the customers desire to activate the primary transaction card use

Cunningham does not explicitly disclose the steps of offering the options of activating the transaction card by

- Determining the customer's election to add a secondary credit card feature; and

De La Rue discloses a Visa smart card that will place the functions of several traditional bank cards onto a single microchip (single card). These additional features include a credit feature, a stored cash feature and a rewards program. It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of De La Rue to the disclosure of Cunningham to create a real time credit card application system and method that would include a multifunction credit card. The system of Cunningham, while originally adapted to automatically apply and activate a traditional credit card would be well served to adapt the system to allow customers to activate the multi-purpose card with multiple functions because many customers would be interested in having this type of card as opposed to many separate cards in an effort to streamline their financial transactions onto one source as opposed to many separate sources. This is the next step in the evolution of the credit card and if the system did not adapt to these changes, customers would seek out a different system that would better suit their needs.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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